

## REMARKS

### Status Summary

Claims 43-78 are pending in the present application, of which claims 43 and 61 are presented in independent form. No claims have been allowed and claims 43-78 stand rejected.

### Claim Rejection(s) - 35 U.S.C. § 102

Claims 43 and 47-55 stand rejected as being anticipated by U.S. Patent No. 7,117,519 to Anderson, et al. (hereinafter "Anderson"). This ground of rejection is respectfully traversed.

As the Federal Circuit recently stated on October 19, 2008 in *Net Moneyin, Inc., v. Verisign, Inc.*, \_\_\_ F. \_\_\_ (Fed. Cir. 2008) (2007-1565), a proper anticipation rejection under 35 U.S.C. § 102 requires more than the disclosure of each element in a cited reference. In order to anticipate under 35 U.S.C. § 102, a reference must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged or combined in the same way as recited in the claim. The prior art reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Any feature not directly taught must be inherently present. See *MPEP* § 2131. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re *Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given

set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

It is respectfully submitted that Anderson does not disclose, explicitly or inherently, the limitations of claims 43 and 47-55 and therefore cannot anticipate these claims because it fails to teach each and every limitation required by these claims as is required by 35 U.S.C. §102 and explained below

Independent claim 43 requires, *inter alia*, downloading an action list from the computer to the portable image capture device; and performing the corresponding file handling action within the portable image capture device on the at least one stored file included in the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list. The corresponding file handling action must be performed within the portable image capture device.

Anderson discloses actions to be taken by a server when the images are uploaded to the server from a handheld image capture device. For example, the abstract of Anderson states "After the user selects at least one of the items in the action list, the images and the selected action list item are sent to the server, and the server performs the specified action on the uploaded images." This clearly indicates that actions are performed on the server. The Office Action states that col. 8, lines 14-46, col. 11, line 32 to col. 13, line 14 disclose the feature of performing, on the at least one stored file included in the portable image capture device, the corresponding file handling action within the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list. It is respectfully submitted that Anderson teaches away from performing, on the at least one stored file included in the portable image capture device, the corresponding

file handling action within the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list.

For example, col. 8, lines 18-22 of Anderson state "When the user initiates an image upload, the action list 48 is displayed to the user so the user may easily select what actions the gateway server 18 should take with respect to the images by selecting the displayed action list items." The preceding states that the gateway server is to perform the actions. A server performing actions clearly is not the same as (and teaches away from) performing the corresponding file handling action within the portable image capture device. Additionally, Col. 8, lines 40-46 states "Based on the action lists 48 and customization, the gateway server 18 may be programmed to automatically perform predefined tasks, such as creating new web albums, or a new page within an existing album, parse the images to extract sound files or other metadata, print images and mail them to designated addresses, and so on." This clearly indicates that the server performs the actions.

Col. 11, line 32 to col. 13, line 39 of Anderson describe an example of a user setting up an account and an action list on a server that is downloaded to the cell phone of the user for use when an input is detected. The action list in the example provides an indication to the server where the images that are being uploaded should be stored. Col. 13, lines 36-39 specifically states that "a method for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device has been disclosed."

It is therefore respectfully submitted that Anderson teaches away from the features of independent claim 43 and therefore does not teach all of the features of claim 43. It is therefore respectfully submitted that the rejection of claim 43 be withdrawn.

Claims 47-55 depend from claim 43 and are believed to patentable for at least the same reasons set forth for claim 43.

With respect to claim 50, Anderson does not disclose a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events. Column 8, lines 7-22 of Anderson teach that each user account in a database may have one or more action lists representing actions the gateway server should take with respect to uploaded images. Clearly, these actions are specific to the server and are independent of the user's type of device. Furthermore, the action list of Anderson is not presented until the user initiates an image upload. Since the action list is not presented until the user initiates an image upload, it follows that a user initiating an image upload is not part of comprising displaying to the user a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events.

Claim 51 requires, *inter alia*, that actions can be performed on the portable image capture device. Anderson, on the other hand, discloses a set of actions that are performed on the server. No teaching or suggestion could be found of actions performed on a portable image capture device. Anderson does not teach displaying a set of actions that can be performed on the portable image capture device when each selected event occurs for the user to map one or more actions to each event.

In view of the foregoing, it is respectfully submitted that Anderson does not teach or suggest all of the features of claims 47-55. It is therefore respectfully requested that the rejection of claims 47-55 be withdrawn.

#### Claim Rejection(s) - 35 U.S.C. § 103

Claims 44-46 and 56-78 stand rejected as being unpatentable over U.S. Patent No. 7,117,519 to Anderson, et al. (hereinafter "Anderson"), in view of U.S. Patent No. 7,283,158 to Shiohara, et al. (hereinafter "Shiohara").

MPEP 2143.03 instructs Examiners to consider each claim feature. In addition to consideration, to establish prima facie obviousness, each claim feature must be present

(i.e., taught or suggested) by an asserted combination. In *re* Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). To establish a prima facie case of obviousness, the Office must first show that the prior art, through cited documents, the nature of the problem being solved, or the knowledge of a person having ordinary skill in the art, describe or suggest all of the claim features. *KSR International v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, it is respectfully submitted that this is why MPEP Section 904 instructs Examiners to conduct an art search that covers “the invention as described and claimed.” (emphasis added). Lastly, the Examiner’s attention is respectfully directed to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Rejections on obviousness grounds cannot be sustained by mere conclusory statements. *Ibid*.

As indicated above, Anderson does not teach or suggest all of the limitations of claim 41. No teaching or suggestion of all of the features of claim 41 could be found in Shiohara. Therefore, neither Anderson nor Shiohara disclose or render obvious, singly or in combination, all of the features of claim 41. Claims 44-46 and 56-60 depend from

claim 41 and are believed to be patentable for at least the same reasons set forth for claim 41.

Claim 45 requires that an executable file associated with a file handling action to be performed be downloaded when the action is to be performed. The cited text of Shiohara in the Office Action states that programs for generating print image data can be installed from an external device as occasion demands. The phrase "as occasion demands" in Shiohara does not mean when the action is to be performed due to the context of Shiohara. In all of the embodiments described, the executable program is only downloaded when the user turns on a program installing switch provided on the camera. See col. 9, line 40 to col. 13, line 47 of Shiohara. Downloading an executable program when a user turns on a program installing switch clearly is not the same as downloading an executable file corresponding to a file handling action when the file handling action is to be performed. Therefore, Shiohara does not disclose or render obvious the feature of claim 45. No disclose or suggestion of the features of claim 45 could be found in Anderson. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 45.

Claim 46 requires that all executable files associated with the file handling actions in the action list be downloaded at the time the action list is downloaded. The Office Action states that the text "reading out the program from the recording medium in the digital medium at a desired team" discloses the features of claim 46. The text preceding the cited text requires that the recording medium that stores the program (received from an external recording medium) be provided in the digital camera. Since the program is already stored in the digital camera, it follows that the program is already downloaded into the digital camera. It is therefore respectfully submitted that the cited text does not teach the features of claim 46. No teaching or suggestion of the features of claim 46 could be found in either Anderson or Shiohara. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 46.

Claim 57 requires that the device send operating environment information to the server in the request in order for the server to find the action executable file appropriate for the device's operating environment. The cited text of Shiohara in its broadest interpretation merely discloses downloading a program into the camera memory and executing the program. Downloading a program does not disclose sending operating environment information to a server in a request in order for the server to find the action executable file appropriate for the device's operating environment. Anderson discloses that actions are performed on the server, so operating information of a portable device is not disclosed or rendered obvious by Anderson. No teaching or suggestion could be found in either Anderson or Shiohara of sending operating environment information to the server in the request in order for the server to find the action executable file appropriate for the device's operating environment. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 57.

Claim 59 requires determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory, thereby performing the action. Shiohara discloses downloading programs to a camera for eventual execution on the camera in response to a user selecting a program installing switch provided on the camera and deleting files. No disclosure of suggestion of determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory, thereby performing the action could be found in Shiohara. Anderson discloses that actions are performed on the server, so determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory is not disclosed or rendered obvious by Anderson. No teaching or suggestion could be found in either Anderson or Shiohara of sending operating environment information to

the server in the request in order for the server to find the action executable file appropriate for the device's operating environment. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 59.

The Office Action states that Anderson does not clearly disclose the features of independent claim 61. Anderson discloses actions to be taken by a server when the images are uploaded to the server from a handheld image capture device. For example, the abstract of Anderson states "After the user selects at least one of the items in the action list, the images and the selected action list item are sent to the server, and the server performs the specified action on the uploaded images." This clearly indicates that actions are performed on the server. It is respectfully submitted that Anderson teaches away from performing, on the at least one stored file included in the portable image capture device, the corresponding file handling action within the portable image capture device when an input event on the portable image capture device is detected that matches one of the user input events in the action list.

For example, col. 8, lines 18-22 of Anderson state "When the user initiates an image upload, the action list 48 is displayed to the user so the user may easily select what actions the gateway server 18 should take with respect to the images by selecting the displayed action list items." The preceding states that the gateway server is to perform the actions. A server performing actions clearly is not the same as (and teaches away from) performing the corresponding file handling action within the portable image capture device. Additionally, Col. 8, lines 40-46 states "Based on the action lists 48 and customization, the gateway server 18 may be programmed to automatically perform predefined tasks, such as creating new web albums, or a new page within an existing album, parse the images to extract sound files or other metadata, print images and mail them to designated addresses, and so on." This clearly indicates that the server performs the actions.

Furthermore, col. 11, line 32 to col. 13, line 39 of Anderson describe an example of a user setting up an account and an action list on a server that is downloaded to the cell phone of the user for use when an input is detected. The action list in the example provides an indication to the server where the images that are being uploaded should be stored. Col. 13, lines 36-39 specifically states that "a method for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device has been disclosed."

It is therefore respectfully submitted that not only does Anderson not clearly disclose the features of claim 61, but Anderson teaches away from the features of independent claim 61 and therefore does not teach or render obvious all of the features of claim 61. No disclosure or suggestion of all of the features of claim 61 could be found in Shiohara. It is therefore respectfully submitted that neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 61.

Claims 62-78 depend from claim 61 and are believed to be patentable for at least the same reasons as set forth above for claim 61.

With respect to claim 64, the Office Action states that the Abstract, Figure 5, and col. 2, line 60 to col. 3, line 35 of Shiohara discloses the features of instructions for downloading the executable file corresponding to the file handling action when the action is to be performed. The cited text of Shiohara in the Office Action states that programs for generating print image data can be installed from an external device as occasion demands. The phrase "as occasion demands" in Shiohara does not mean when the action is to be performed due to the context of Shiohara. In all of the embodiments described, the executable program is only downloaded when the user turns on a program installing switch provided on the camera. See col. 9, line 40 to col. 13, line 47 of Shiohara. Downloading an executable program when a user turns on a program installing switch clearly is clearly not the same as downloading an executable file corresponding to a file handling action when the file handling action is to be

performed. Therefore, Shiohara does not disclose or render obvious the feature of claim 64. No disclose or suggestion of the features of claim 64 could be found in Anderson. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 64.

Claim 65 requires instructions for downloading all the executable files associated with the actions in the action list at the time the action list is downloaded. The cited text and figure requires that the recording medium that stores the program (received from an external recording medium) be provided in the digital camera. Since the program is already stored in the digital camera, it follows that the program is already downloaded into the digital camera. It is therefore respectfully submitted that the cited text does not teach the features of claim 65. No teaching or suggestion of the features of claim 65 could be found in either Anderson or Shiohara. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 65.

Claim 69 requires instructions for displaying to the user a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events. Anderson discloses that the items in the action list be performed on a server, so Anderson does not disclose or render obvious the feature of supported user interface input events. Shiohara discloses downloading programs to a camera for eventual execution on the camera in response to a user selecting a program installing switch provided on the camera. No teaching or suggestion could be found in Shiohara of instructions for displaying to the user a list of supported user interface input events specific to the user's type of device for the user to select a desired set of input events. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 69.

Claim 70 requires instructions for displaying a set of available actions that can be performed when each selected event occurs and providing an interface for the user to map one or more actions to each event. Anderson discloses that the items in the action

list of Anderson be performed on a server, so Anderson does not disclose or render obvious the features of displaying a set of available actions that can be performed when each selected event occurs and providing an interface for the user to map one or more actions to each event. As previously indicated, Shiohara discloses downloading programs to a camera for eventual execution on the camera in response to a user selecting a program installing switch provided on the camera. No discussion of events could be found in Shiohara. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all the feature of instructions for displaying a set of available actions that can be performed when each selected event occurs and providing an interface for the user to map one or more actions to each event.

Claim 77 requires determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory, thereby performing the action. Shiohara discloses downloading programs to a camera for eventual execution on the camera in response to a user selecting a program installing switch provided on the camera and deleting files. No disclosure of suggestion of determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory, thereby performing the action could be found in Shiohara. Anderson discloses that actions are performed on the server, so determining if the executable file is present in memory of the portable image capture device and if the executable file is present in the memory, retrieving and executing the executable file from the memory is not disclosed or rendered obvious by Anderson. No teaching or suggestion could be found in either Anderson or Shiohara of sending operating environment information to the server in the request in order for the server to find the action executable file appropriate for the device's operating environment. Therefore, neither Anderson nor Shiohara, singly or in combination, disclose or render obvious all of the features of claim 77.

In view of the preceding remarks, it is therefore respectfully requested that the rejection of claims 44-46 and 56-78 be withdrawn.

#### CONCLUSION

In view of the above, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. The absence of additional patentability arguments should not be construed as either a disclaimer of such arguments or that such arguments are not believed to be meritorious. The Examiner is respectfully requested to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action or the filing of a Notice of Appeal.

#### DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, associated with the filing of this paper to Deposit Account No. 50-3512.

Respectfully submitted,

Date: January 10, 2009

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